

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

University of Southern California	)	Opposition No.: 125,615
	)	
Opposer,	)	Serial No.: 75/358,031
	)	
vs.	)	Mark: "SC" (Stylized)
	)	
University of South Carolina,	)	
	)	
Applicant.	)	
	)	

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**APPLICANT'S ANSWER TO AMENDED NOTICE OF OPPOSITION  
AND COUNTERCLAIM FOR CANCELLATION OF U.S. REG. NO. 2,683,137**

The Applicant, University of South Carolina ("Applicant"), through its undersigned attorneys, hereby submits its Answer to the Amended Notice of Opposition filed by University of Southern California ("Opposer") against its application for registration of the mark "SC" (Stylized), Serial No.: 75/358,031, filed September 16, 1997, and published in the Official Gazette of May 18, 1999, as follows:

1. Unless expressly admitted herein, each allegation contained in the Notice of Opposition is denied.

2. As to paragraph 1 of the Notice of Opposition, Applicant lacks information sufficient to form a belief as to whether the Notice of Opposition was timely filed, and therefore, denies those allegations. The Applicant admits the remaining allegations of paragraph 1 of the Notice of Opposition.

3. As to paragraph 2 of the Notice of Opposition, Applicant admits only that Opposer has received a registration for "SC," U.S. Reg. No. 1,844,953 and that this registration speaks for itself. Applicant lacks information sufficient to form a belief as to the truth of the

allegations concerning the dates of use of the goods and services contained paragraph 2 of the Notice of Opposition, and therefore, denies those allegations. Applicant denies that the mark is famous. Applicant denies the remaining allegations of paragraph 2 of the Notice of Opposition.

4. In response to paragraph 3 of the Notice of Opposition, Applicant admits only that the opposed application was in International Class 25. Applicant denies the remaining allegations of paragraph 3 of the Notice of Opposition and would further show that there is no likelihood of confusion between Opposer's and Applicant's stylized mark that has been opposed.

5. Applicant denies the allegations of paragraph 4 of the Notice of Opposition and would further show that it is senior in priority having used the letters "SC" as a mark at least as early as 1801.

6. As to Paragraph 5 of the Notice of Opposition, Applicant denies that Opposer possesses any common law rights in the "SC" mark. Applicant lacks information sufficient to form a belief as to the truth of the remaining allegations of paragraph 5 of the Notice of Opposition, and therefore, denies those allegations.

7. As to paragraph 6 of the Notice of Opposition, Applicant admits only that Opposer is the owner of U.S. Reg. No. 2,683,137 and that this registration speaks for itself. Applicant lacks information sufficient to form a belief as to the truth of the remaining allegations of paragraph 6 of the Notice of Opposition, and therefore, denies those allegations. Applicant would further state that, pursuant to its Counterclaim which is being filed herewith, U.S. Reg. No. 2,683,137 should be cancelled.

8. Applicant denies the allegations of paragraph 7 of the Notice of Opposition.

9. As to paragraphs 8 and 9 of the Notice of Opposition, Applicant lacks information sufficient to form a belief as to the truth of the allegations regarding the extent of Opposer's advertisements and its expenditures, and therefore, denies those allegations. Applicant denies the remaining allegations of paragraph 8 and 9 of the Notice of Opposition. Applicant denies that the Opposer's "SC" mark is famous.

10. Applicant denies the allegations of paragraph 10 of the Notice of Opposition.

11. Applicant denies the allegations of paragraph 11 of the Notice of Opposition and would further show that there is no possibility of any injury to Opposer through the granting of Applicant's registration.

12. Paragraph 12 of the Notice of Opposition contains legal conclusions to which no response is required. However, to the extent a response is required, Applicant denies the allegations contained in Paragraph 12 of the Notice of Opposition.

#### **FIRST AFFIRMATIVE DEFENSE**

13. Opposer's Notice of Opposition fails to set forth facts sufficient to entitle the Opposer to the relief sought and should be dismissed pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure. Applicant reserves the right to file a motion to dismiss.

#### **SECOND AFFIRMATIVE DEFENSE**

14. Opposer is not entitled to relief because there is no likelihood of confusion, mistake or deception because the Opposer's mark and the Applicant's mark are not confusingly similar, are used in connection with dissimilar goods and services, are sold through different channels of trade, and the relevant consuming public are discerning customers who can easily differentiate between their favorite team's products.

### **THIRD AFFIRMATIVE DEFENSE**

15. Opposer has waived any and all claims against Applicant over the use of the "SC" (Stylized) mark.

### **FOURTH AFFIRMATIVE DEFENSE**

16. Opposer is not entitled to relief because Opposer's marks are generic or descriptive and incapable of serving as an indicator of source.

### **FIFTH AFFIRMATIVE DEFENSE**

17. Opposer lacks standing to bring this Opposition Proceeding.

### **SIXTH AFFIRMATIVE DEFENSE**

18. Opposer's Notice of Opposition should be dismissed because Opposer has previously released any claims against Applicant.

### **SEVENTH AFFIRMATIVE DEFENSE**

19. Opposer should be estopped from opposing Applicant's registration of the "SC" (Stylized) mark.

### **EIGHTH AFFIRMATIVE DEFENSE**

20. Opposer should be barred from opposing Applicant's registration of the "SC" (Stylized) mark under the doctrine of Laches.

### **NINTH AFFIRMATIVE DEFENSE AND COUNTERCLAIM**

### **PETITION TO CANCEL**

The University of South Carolina ("Petitioner") an agency duly organized and existing under the laws of the State of South Carolina and having an address of 109 Osbourne Administration Building, Columbia, South Carolina, 29208, hereby seeks cancellation of the mark "SC" (Stylized), U.S. Reg. No. 2,683,137, owned by the University of Southern California

("Registrant"), a California non-profit corporation located at University Park, ADM 352, Los Angeles, California, 90089.

As grounds for cancellation it is alleged:

21. Petitioner is an agency duly organized and existing under the laws of the State of South Carolina and having an address of 109 Osbourne Administration Building, Columbia, South Carolina, 29208.

22. Petitioner is a state sponsored educational institution of higher education.

23. South Carolina was the eighth of the original 13 colonies of the United States. South Carolina became a state on May 23, 1788.

24. Since at least as early as the Revolutionary War, in approximately 1775, the government that became the State of South Carolina adopted the abbreviation "SC" as a symbol and insignia of the State of South Carolina. For instance, the letters "SC" were used on uniforms, flags and other items during the Revolutionary War and Civil War by the State of South Carolina.

25. The government of the State of South Carolina established the South Carolina College on December 19, 1801, as part of an effort to unite South Carolinians in the wake of the Revolutionary War. South Carolina's leaders saw the new college as a way to promote "the good order and harmony" of the state. In 1906, the college was re-chartered and the institutional name was changed to the University of South Carolina.

26. The Petitioner adopted and has continuously used the letters "SC" since around the time of its founding in 1801 as a trademark in connection with its educational services, live exhibitions of its athletic teams, retails sales of the Petitioner's products and in connection with various goods sold or licensed to be sold by the Petitioner, including but not

limited to, clothing, sporting goods and school supplies. As a result, Petitioner has common law trademark rights in the "SC" mark. For instance, some thirty years prior to the Registrant, the 1963 University of South Carolina football team used the letters "SC" in a similar descending manner.

27. For over two hundred years, the Petitioner has extensively advertised and promoted its educational services, athletic events and related products bearing the "SC" mark. Petitioner has spent considerable sums of money on such marketing throughout the United States.

28. The Petitioner has also received significant media coverage and has a huge base of fans that recognize the "SC" Mark. As a result of such extensive media coverage, advertisement and promotion of the "SC" mark, the mark has gained widespread and favorable public acceptance, recognition and goodwill. The "SC" mark is a famous and distinctive mark for the Petitioner. The letters "SC" point uniquely and unmistakably to the Petitioner.

29. Registrant is the owner of U.S. Registration No. 2,683,137 for "SC" (Stylized) used in connection with various goods and services in International Class 12, 16, 18, 21, 24, 25, 28, 35, and 41. The date of first use for all International Classes is 1993.

30. Registrant's registration of the letters "SC" (Stylized) in Registration No. 2,683,137 are similar to the letters "SC" which were previously adopted and continuously used by the Petitioner as earlier alleged.

31. Based upon the foregoing, Petitioner possesses common law rights in the letters "SC" which are superior to the rights possessed by the Registrant. Specifically, Petitioner adopted and used the letters "SC" prior to Registrant.

32. Registrant is not connected with, sponsored by or related in any way with any activities performed by the Petitioner.

33. Registrant has opposed the Petitioner's application to register the "SC" Baseball Logo, Serial No. 75/358,031, which consists of a unique script representation of the letters overlapped upon each other. In this action, the Petitioner has asserted, among other defenses, that there is no likelihood of confusion based upon differences its unique design, limitations of channels of trade in the University of Southern California's incontestable registration (U.S. Reg. No.1,844,953) and on the sophistication of the parties' respective purchasers. However, with respect to the University of Southern California's common law rights and U.S. Reg. No. 2,683,137, if there is finding of a likelihood of confusion, the Petitioner, the University of South Carolina, possesses superior common law rights to the "SC" mark.

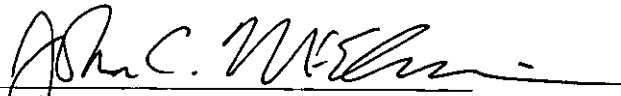
34. If the Registrant is permitted to retain registration of U.S. Reg. No. 2,683,137 and seek cancellation of the "SC" Baseball Logo, Serial No. 75/358,031, under a theory of a likelihood of confusion, the Petitioner will be damaged as it is the senior use of the "SC" mark.

35. Petitioner's "SC" mark is famous and Registrant's use and continued registration of U.S. Reg. No. 2,683,137 will cause dilution of its "SC" mark.

WHEREFORE, having fully answered the Amended Notice of Opposition, the Applicant/Petitioner prays that the Opposition be dismissed, with prejudice, that its registration issue forthwith, that Opposer/Registrant's registration for U.S. Reg. No. 2,683,137 be cancelled, and for such other and further relief as the Trademark Trial and Appeal Board may deem just and proper.

The filing fees required by 37 C.F.R. 2.6(a)(16) are enclosed herewith

NELSON MULLINS RILEY & SCARBOROUGH, L.L.P.

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Charleston, South Carolina

9/15, 2004

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to: Assistant Commissioner for Trademarks 2900 Crystal Drive Arlington, Virginia 22202-3513.



Date: 9/15/04



CERTIFICATE OF SERVICE

I, the undersigned Administrative Assistant of the law offices of Nelson Mullins Riley & Scarborough, L.L.P., attorneys for Applicant do hereby certify that I have served all counsel in this action with a copy of the pleading(s) hereinbelow specified by mailing a copy of the same by United States Postal Service First Class Mail, with proper postage thereon, to the following address(es):

Pleadings:

**Answer to Amended Notice of Opposition and Counterclaim  
for Cancellation of U.S. Reg. No. 2,683,137**

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September 15, 2004

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

RE: University of South California v. University of South Carolina  
Opposition No. 125,615

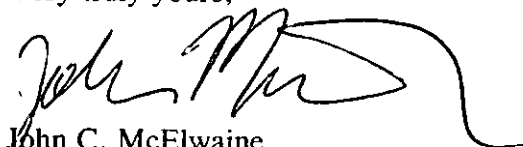
Dear Assistant Commissioner:

Please find enclosed an original and two copies of **Applicant's Answer to Amended Notice of Opposition and Counterclaim for Cancellation**. Along with this filing, we have enclosed the applicable fees for the Counterclaim.

By copy of this letter we are serving the opposing counsel with these pleadings.

Thank you for your assistance in this matter.

Very truly yours,



John C. McElwaine

Enclosures

cc: Michael S. Adler, Esquire (w/encl.)



09-20-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #40